

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Enrique PABLOS

Serial No.: 10/563,590

Group No.: 1621

Filed: March 1, 2007

Examiner: Marialouisa Lao

For: METHOD FOR THE PRODUCTION ON METAL CARBOXYLATES AND THE METAL AMINOATE OR METAL HYDROXY ANALOGUE METHIONATE DERIVATIVES THEREOF, AND USE OF SAME AS GROWTH PROMOTERS IN ANIMAL FEED

Attorney Docket No.: U016100-0

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO FINAL ACTION

The Official Action of 18 August 2008 has been carefully considered and reconsideration of the application in view of the present submission is respectfully requested.

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Claims 53-67 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Hsu (US '815) and Hsu (US '055) in view of Ericson et al. Applicant respectfully traverses this rejection.

The claims under examination are directed to **a process** for preparing a feed supplement, which process comprises at least the following three (3) **process steps**:

(1) **preparing a dry metal carboxylate** of formula $M(RCOOH)$ in the manner and under the conditions recited in subparagraph (i) of claim 53;

(2) **preparing a metal aminoate** in the manner and under the conditions recited in subparagraph (ii) of claim 53; and

(3) **mixing the dry metal carboxylate and the metal aminoate** in the manner and under the conditions recited in subparagraph (iii) of claim 53.

Of the three (3) claimed process steps identified above, the Examiner has pointed in the prior art to only one step- -the preparation of a metal aminoate- -that even arguably relates to this process. Thus, although the claimed process steps require the separate preparation of a dry metal carboxylate, including a step to remove water (claim 53, step (i)), and a separate step of mixing the dry metal carboxylate and the metal aminoate (claim 53, step (ii)), the only **process step** on which the Examiner relies in the references is a single step of “blending a metal salt, an amino acid and an organic hydroxy acid in deaerated (sic: deaerated) water” (Official Action at paragraph 6).

The Examiner has respectfully not provided any motivation, reason or

explanation why one of skill in the art would have performed steps (i) and (iii) of the claimed process, including the separate formation of a dry metal carboxylate with the removal of water, when the references teach blending of the described components in water in a single step. Indeed, Applicant respectfully submits that this teaching of the reference precludes the modification proposed by the Examiner. See MPEP 2143.01(VI) (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”).

The Examiner has acknowledged that the cited references do not show two of the three claimed method steps (Official Action at paragraph 8). The Examiner nevertheless contends that “the stepwise addition or steps” recited in the claims would have been obvious (Official Action at paragraph 9), but respectfully does not provide any support for this contention. Indeed, the only paragraph in the Official Action which purports to address this issue (paragraph 9) contains only conclusory statements as to why it would have been obvious to react organic acids other than those described in the references with well-known amino acids (see paragraph 9). But, this does not support the contention that **the steps** of the claimed **process** would have been obvious, and the Examiner cannot rely on conclusory statements or alleged “common knowledge” in this respect. See MPEP 2142; see, also, MPEP 2144.03 (“It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.”).

The Examiner contends at paragraph 15 of the Official Action that

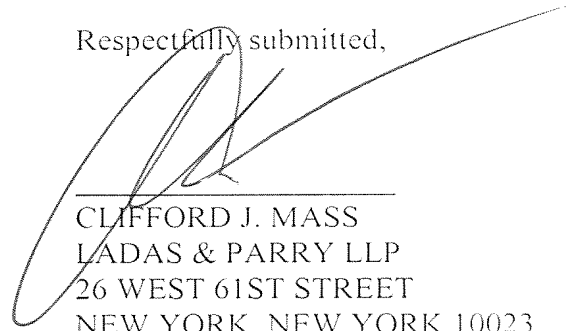
“Applicants have not refuted that the instant carboxylate-aminoate metal complex is equivalent to the cited prior art references metal complex, which engages the use of the equivalent materials (i.e., acid, amino acid and metal salts) to form a metal complex.”

The thrust of the Examiner’s contention appears to be that **the product** formed in Hsu is allegedly equivalent to the product formed by the claimed process such that the claimed process steps would have been obvious. Even assuming for the sake of argument that the products were equivalent (which they are not), the Examiner’s contention is a *non sequitur*. It does not follow that a process for making a product is obvious even if the product were obvious. This is especially true where, as here, the Examiner has required restriction between the product and the process as being drawn to different inventions.

In short, in the absence of anything in the prior art to show or suggest the claimed process steps, the Examiner cannot set forth even a *prima facie* case of obviousness for the invention as claimed. See MPEP 2142. In the initial instance, it is the obligation of the Examiner, not the Applicant, to come forward with the production of evidence to support a rejection. MPEP 2142 (“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”). This the Examiner has respectfully not done.

For the above reasons, Applicant respectfully submit that the sole remaining rejection of record has been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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